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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Seiichi MIYAZAKI

Group Art Unit: 2823

Application No.: 09/913,334

Examiner: G. Fourson III

Filed: August 13, 2001

Docket No.: 110386

For: ETCHANT, ETCHING METHOD AND SEMICONDUCTOR SILICON WAFER

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the April 22, 2003 Restriction (sic, Lack of Unity of Invention)

Requirement, Applicant hereby provisionally elects Group II, claims 38-40, with traverse.

I. Unity of Invention Exists as Between Groups I and II

Applicants respectfully assert that the Requirement is improper under the rules of practice in PCT national stage applications, because the appropriate unity of invention standards have not been properly applied by the Patent Office. In PCT national stage applications, the Examiner may issue a restriction-type Requirement if no unity of invention exists. However, the Examiner must state why there is no "single general inventive concept." See MPEP §1893.03(d). Therefore, a single application may include one invention, or more than one invention if the inventions are "linked as to form a single general inventive concept." Id. (emphasis added). If multiple inventions are included in the application, they are deemed to be linked if there exists a "technical relationship among the inventions that involves at least one common or corresponding special technical feature." Id.

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The Office Action asserts that Groups I and II are related as product and process of use. The Examiner's attention is directed to Annex B, Part 2, of the PCT Administrative Instructions (MPEP Appendix AI). At least Example 1 specifically demonstrates that unity of invention can exist between a product and use of the product when the claims share a special technical feature. In the instant application, the method of the Group II claims 38-40 share common features with the Group I claims 21-37. Specifically, the methods of claims 38, 39 and 40 include an etchant that includes the features of claim 21, 36 and 37 respectively.

Thus, Groups I and II possess unity of invention and should not be subject to a Restriction or Unity of Invention Requirement.

II. There is No Undue Burden on the Examiner

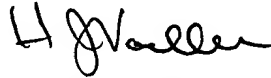
It is respectfully submitted that the subject matter of all claims 21-42 are sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

III. Conclusion

Should the Examiner have any questions regarding this response or the application in general, he is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



William P. Berridge
Registration No. 30,024

H. James Voeller
Registration No. 48,015

WPB:HJV/hjv

Date: May 20, 2003

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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